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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,468	11/03/2003	Kazuhisa Arai	33773M054	1848
441	7590	09/22/2005	EXAMINER	
SMITH, GAMBRELL & RUSSELL, LLP 1850 M STREET, N.W., SUITE 800 WASHINGTON, DC 20036			TRINH, HOA B	
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/698,468

Applicant(s)

ARAI, KAZUHISA

Examiner

Vikki H. Trinh

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07/20/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgement***

1. Claims 1-4 are pending in this present application.

### ***Specification***

2. The disclosure is objected to because of the following informalities: In the specification, page 3, line 19, reference number 21 is called base plate, while in line 21, reference number 21 is called substrate. It is recommended that consistent terminology is preferred when describing any part of the present invention with reference number. Also, on page 2 of the specification, line 27, the phrase "prior art" should be inserted before "diagram", because applicant has admitted that the drawing figure is from a prior art reference, as stated on page 3, lines 13-14, of the specification.

Appropriate correction is required.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference number 3 in figure 3 is not described in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

Art Unit: 2814

1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR

1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR

1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Chung et al. (6,743,694) (hereinafter Chung).

As to claims 1 and 3, Chung teaches a semiconductor wafer (col. 1, line 15) having circuits (col. 1, lines 13-17) formed on the front surface of a wafer or base plate, wherein an ID

mark (col. 1, line 17) is formed in the interior of the base plate or wafer at a predetermined position devoid of the circuits (col. 1, lines 13-17). Note that the base plate is an integral part of the substrate/wafer. A "workpiece holding area" is a part of the substrate where the chips/circuits are disposed on the substrate.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2 and 4 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chung, as applied to claims 1 and 3 above.

As to claims 2 and 4, Chung the invention substantially as claimed, including the ID mark using laser (col. 1, lines 13-17). However, Chung does not explicitly teach the step, whereby the ID mark is formed by converging the laser beam having a wavelength of 1064 nm at a focal point of the base plate. Nonetheless, it would have been obvious to one of ordinary skill

Art Unit: 2814

in the art at the time the invention was made to construct the invention of Chung with the step as claimed, because applicant's claims are product claims, which do not depend on the method step for patentability. Note that if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

6. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung, as applied to claims 1 and 3 above, in view of Hayashi (JP 11-267861, applicant previously cited and described in the specification, page 3, lines 13-17), and further in view of Matsumura et al. (6,248,973) (hereinafter Matsumura).

Chung discloses the invention substantially as claimed. However, Chung does not explicitly teach that converging a laser beam having a wavelength of 1064 nm at a focal point forms the laser marking.

Hayashi discloses an analogous ID marking in the interior of a substrate 1 (abstract, fig. 2). The marking 7 (fig. 10) is formed by converging the laser light beam 3 (fig. 10) at a focal point in the interior of the substrate 1 (fig. 10). However, Hayashi does not explicitly teach the wavelength of the laser beam used.

Matsumura teaches an analogous marking in the interior of a substrate (w) (fig. 4c) using laser beam. The marking is done by using the laser beam (YAG laser) having a wavelength that is approximately equal to 1064 nm, as claimed. (col. 7, lines 40-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Chung with the laser marking step of converging

Art Unit: 2814

the laser beam, as taught by Hayashi, so as to ensure that the ID marking is in the interior of the substrate without leaving any ridges or breakage around the marking area on the substrate. (See Hayashi, Abstract) Furthermore, the combined teaching of Chung and Hayashi is provided with a laser beam having a wavelength of approximately 1064 nm, as taught by Matsumura, so as to produce the ID marking in the substrate.

### ***Response to Arguments***

7. Applicant's arguments filed 07/20/05 have been fully considered but are moot in view of the new ground of rejection.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP patents to Usui et al and Yokoo et al., each teach a laser marking in the inside of the substrate by converging the laser beam. (Abstract)


8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Vikki Trinh whose telephone number is (571) 272-1719. The Examiner can normally be reached from Monday-Friday, 9:00 AM - 5:30 PM Eastern Time. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Wael Fahmy, can be reached at (571) 272-1705. The office fax number is 703-872-9306.

Any request for information regarding to the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Also, status information for published applications may be obtained from either Private PAIR or

Art Unit: 2814

Public Pair. In addition, status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspro.gov>. If you have questions pertaining to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Lastly, paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions as of June 2004. Paper copies of foreign patents and non-patent literature will continue to be included with office actions. These cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. patent or patent application publications will not be granted.

  
Vikki Trinh,  
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